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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,409	07/03/2003	David J. Good	3023.PKG	4461

7590
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EXAMINER

SCHATZ, CHRISTOPHER T

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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06/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/613,409

Applicant(s)

GOOD ET AL.

Examiner

CHRISTOPHER SCHATZ

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10, 12, 22 and 25-29 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8, 10, 12, 22 and 25-29 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on August 18, 2008, PROSECUTION IS HEREBY REOPENED. The new grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 8, 10, 12, 13, 22 and 25-29 rejected under 35 U.S.C. 103(a) as being unpatentable over Mehaffy et al. (EP 0934990).

At the outset, the applicant is notified that the limitation in the independent claims stating that the adhesive "is applied at a temperature of below 250 °F" is a method limitation and thus does further limit the claim because method limitations do not further limit product claims. Claims 1 and 26 only require an adhesive that is capable of being applied at less than 250 °F, with a viscosity within applicant's claimed range at a temperature of below 250 °F and a heat stress value that is separated from the application temperature by less than 100 °F.

As to claims 1-3 and 22, paragraph 33 discloses an adhesive that is applied at 200 °F, wherein the heat stress value is separated by 90 °F or less from the application temperature. Specifically, paragraph 0033 states that the adhesive can be applied at 200°F and that "a bond formed by two pieces of corrugated case substrate held together by a 1/2" by 2" compressed bead can maintain a cantilever stress load of 2 to 2.5 psi for 24 hours at temperatures at or above 115 degree F." Examiner interprets 115°F as the heat stress value. The reference does not explicitly recite the viscosity of the adhesive at 200 °F. However, the adhesive disclosed in the reference and the adhesive disclosed in the applicant's specification are of substantially identical compositions. More specifically, applicant states that the adhesive of the instant application comprises: EVA copolymer from about 10% to 60%, a tackifying component with a Ring and Ball softening point between 70°C and 150°C, and paraffin wax from Moore & Munger from 10% to 60% (pages 9-11). Applicant should note that Mehaffy et

al. discloses a hot melt adhesive with the same components and composition (paragraphs 0009-0018, 0029). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art that the viscosity of the hot melt adhesive at 200 °F is within the applicant's claimed range because the adhesive in the reference is substantially similar to the adhesive disclosed by the applicant. The applicant is referred to MPEP. 2112 (V).

As to claims 4 and 5, at the time of the invention it would have been obvious to a person of ordinary skill in the art that the adhesive disclosed by Mehaffy et al. would have the same crystallization properties and exhibit the same viscosity change as claimed by the applicant in claims 4 and 5 because Mehaffy discloses the same adhesive as the instant application. As to claim 8, Mehaffy et al. discloses an article of manufacture comprising the adhesive of claim 1 (paragraph 0034). As to claim 10, Mehaffy et al. discloses the article of manufacture is a carton, case, tray or bag (paragraph 0034). As to claims 12 and 13, Mehaffy et al. discloses a packaged food article contained within a carton, case, tray or bag wherein the carton, case, tray or bag contains the adhesive of claim 1 (paragraph 0034). As to claim 25, Mehaffy et al. discloses an adhesive comprising an ethylene n-butyl acrylate copolymer (0021). As to claim 26, the applicant is referred to the discussion of claims 1, 4 and 5 for the reasons as to the why the reference renders the limitations of the claim obvious. As to claim 27, Mehaffy et al. discloses an adhesive comprising 20 wt % of an ethylene n-butyl acrylate copolymer and 10 wt % of an ethylene vinyl acetate copolymer (0025 and 0026). As to claims 28 and 29, the applicant is referred to the discussion of claims 2 and 3 above.

4. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehaffy et al. as applied above, and further in view of Baetzold et al. '913.

Mehaffy et al. discloses a hot melt adhesive as stated above, and the reference further discloses that "other additives" can be added depending on the end use of said adhesive. The reference is silent as to whether or not said additives comprise a fragrance or an energy-absorbing ingredient. Baetzold et al. discloses a hot melt adhesive which can be used in packaging (column lines 10-12), and further discloses that the presence of fragrances and energy absorbing ingredients is well known in the art (abstract, column 4, lines 17-31). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to add a fragrance and/or an energy-absorbing ingredient to the hot melt adhesive of Mehaffy et al. because the use of said ingredients is well known as taught by Baetzold et al.

Response to Arguments

5. Applicant's arguments filed 03/13/2009 have been fully considered. The applicant's arguments stating that Table 1 does not disclose the limitations of claim 1 are moot in light of the new grounds of rejection. The new grounds of rejection presented above do not rely on the disclosure in Table I. Rather the rejection relies on the embodiment presented in paragraph 33 of Mehaffy. The applicant argues that Mehaffy does not disclose an adhesive capable of being applied at 200 °F with a heat stress value that is separated from the application temperature by less than 100 °F. The applicant is referred to paragraph 33 of the reference. The applicant's arguments stating

that it well known in the art that the heat stress values are dependent on the application temperature is not germane to the grounds of the rejection as currently applied.

The applicant states that the position that because Mehaffy discloses the substantially the same adhesive as disclosed by the applicant and thus will have the same heat stress value is without merit. The current grounds of rejection do not rely on such a position. Mehaffy explicitly discloses a heat stress value separated by less than 100 °F from the application temperature of 200 °F.

The applicant argues that Mehaffy does not disclose the limitations of claims 5, 26 or 27. The applicant is referred to the new grounds of rejection above. Mehaffy discloses substantially the same adhesive as disclosed by the applicant, and thus Mehaffy discloses the viscosity, crystallization and viscosity change properties required by the claims. The burden is on the applicant to show an unobvious difference. MPEP 2112 (V).

The applicant states that although paragraph 33 of Mehaffy discloses that the adhesive is capable of being applied at 200 °F to 300 °F, the artisan looking at the reported heat stress values of 115-125 °F would recognize that if the adhesives of Table I was applied at or below 200 °F, the heat stress value would decrease. This statement is not sufficient to show that heat stress value decreases with application temperature. The burden is on the applicant to present evidence that the heat stress values of the specific adhesives disclosed in Table I will decrease if the application temperature is decreased to 200 °F. Second, even if the applicant presents such evidence, it is possible that the adhesive with the heat stress value of 125 °F at an application

temperature of 250 °F will have a heat stress separated from the application temperature by less than 100 °F when the applicant temperature is 200 °F because the heat stress value could decrease by as much as 14 °F when the application temperature decreases from 250 °F to 200 °F and still meet the claimed limitation. Finally, the applicant does not address the disclosure in section 33 that the heat stress value is 115 °F when the application temperature is 200 °F. The disclosure of a reference is not limited to the examples, and no data or arguments presented by the applicant changes the disclosure in paragraph 33 that the adhesive has a heat stress value of 115 °F at an application temperature of 200 °F.

With respect to the applicant's arguments directed toward claims 6 and 7, the arguments are moot because Mehaffy discloses an adhesive with applicant's claimed heat stress value at the applicant's claimed application temperature as discussed above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER SCHATZ whose telephone number is 571-272-6038. The examiner can normally be reached on Monday through Friday 9 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeff H. Aftergut/
Primary Examiner, Art Unit 1791

/CHRISTOPHER SCHATZ/
Examiner, Art Unit 1791